



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/573,777

03/28/2006

William F. Rossiter

0579-1121

5523

466 7590 04/15/2011

YOUNG & THOMPSON
209 Madison Street
Suite 500
Alexandria, VA 22314

EXAMINER

ANDLER, MICHAEL S

ART UNIT

PAPER NUMBER

2876

NOTIFICATION DATE

DELIVERY MODE

04/15/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary	Application No. 10/573,777	Applicant(s) ROSSITER, WILLIAM F.	
	Examiner Michael Andler	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10,12-15,18 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10,12-15,18 and 20-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The examiner acknowledges and has entered the arguments filed on 18 January 2011. New claims **29-30** are added by this amendment. Claims **1, 3-8, 10, 12-15, 18 and 20-30** are currently pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

a) Claims **1 and 27** are rejected under 35 U.S.C. 102(e) as being anticipated by Blank (US 6,588,658).

Regarding claims **1 and 27**, Blank discloses a card (See Fig 4 and Abstract), comprising:

a card body (Fig 1: item 1), comprised of:

i) a microcircuit card (Fig 4: item 20d and Col 7: lines 49-52) precut in the card body (Col 6: lines 5-10),

ii) a token (Fig 4: item 20c) precut in the card body (Col 6: lines 5-10) so as to be adjacent to the microcircuit card and extending up to a corner of the card body (Fig 4),
and

Art Unit: 2876

iii) an L-shaped remainder portion of the card body extending along outermost sides of the card body to form three outermost corners of the card (Fig 1: items 10, 20a and 20b) removably joined to both the microcircuit card and the token (Col 6: lines 5-10),

the token carrying visual information (Fig 4: item 23) and including a hole through a thickness of the token configured to receive a key-ring (Fig 4: item 21) such that the token may be carried by the key-ring (Col 6: lines 3-4).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a) Claims **1, 7-8, 10, 12-15, 24-27**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa et al. (US 5,581,065) in view of Smith et al. (US 7,065,195) and Pentz et al. (US 6,471,127).

Regarding claims **1, 12-15 and 27**, Nishikawa et al. discloses a card, comprising:
a card body (Fig 47B: item 40),
comprised of a microcircuit card precut in the card body (See Fig 47B: item 41),
a token precut in the card body so as to be adjacent to the microcircuit card and extending up to a corner of the card body (Fig 47B: item 43), and

the token carrying visual information (See Fig 47B).

Nishikawa et al. suggests an invention for providing a combined SIM card and a telephone calling card (See Fig 47B).

Nishikawa et al. does not specifically teach a remainder portion of the card body removably joined to both the microcircuit card and the token, and including a hole through a thickness of the token configured to receive a key-ring such that the token may be carried by the key-ring, wherein the hole is in a corner of the token in a vicinity of the microcircuit card, wherein the token is a contactless type; wherein the visual information comprises characters in relief.

Smith et al. discloses a remainder portion of the card body removably joined to both the microcircuit card and the token (See Fig 1A: item 120 where a remainder portion, in general, can be considered any portion of the card body that remains after removal of the microcircuit card) and wherein the token is connected to the remainder portion of the card body by mechanically weakened areas consisting of grooves (Col 3, lines 4-6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the teachings of Nishikawa et al. with the invention of Smith et al. in order to provide a means of allowing a user to conveniently carry a telephone calling card number on a key ring (See Smith et al., Fig 1D).

Nishikawa et al. suggests an invention for providing a combined SIM card and a telephone calling card that are removable from one another (See Fig 47B).

Smith et al. suggests an invention for providing a combined keytag portion and a miniature telephone calling card portion that are removable from one another (See Fig 1A).

Nishikawa et al. and Smith et al. do not specifically teach including a hole through a thickness of the token configured to receive a key-ring such that the token may be carried by the key-ring, wherein the hole is in a corner of the token in a vicinity of the microcircuit card, wherein the token is a contactless type, wherein the visual information comprises characters in relief.

Pentz et al. discloses including a hole through a thickness of the token configured to receive a key-ring such that the token may be carried by the key-ring, wherein the hole is in a corner of the token in a vicinity of the microcircuit card (See Fig 2A, item 22), wherein the token is a contactless (RFID) type (Col 5, line 14), wherein the visual information comprises characters in relief (Fig 1A, item 11: raised lettering).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the teachings of Nishikawa et al. with the invention of Pentz et al. in order to provide a means of allowing a user to conveniently carry a telephone calling card on a key ring (See Pentz et al., Abstract).

Regarding claim **7**, Nishikawa et al. discloses wherein the card body conforms to ID-1 format (Col 27, lines 4-6 and Col 21, lines 25-27).

Regarding claim **8**, Nishikawa et al. discloses wherein the microcircuit card conforms to ID-000 format (Col 1, line 21).

Art Unit: 2876

Regarding claim **10**, Nishikawa et al. discloses wherein the token includes a magnetic strip configured to store information (Fig 38, item 75).

Regarding claim **24**, Nishikawa et al. discloses wherein the visual information includes personalizing information (See Fig 33A, item 17A: individual identification information).

Regarding claim **25**, Nishikawa et al. discloses wherein the visual information includes an address or a phone number (Fig 47B).

Regarding claim **26**, Nishikawa et al. discloses wherein the visual information is provided in ink (See Fig 1A, item 62: print information).

b) Claims **3-6, 18 and 20-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa et al. (US 5,581,065) as modified by Smith et al. (US 7,065,195) and Pentz et al. (US 6,471,127) as applied to claim **1** above, and further in view of Lubking (D498,788).

Regarding claims **3-4 and 21-23**, Nishikawa et al. as modified by Smith et al. and Pentz et al. as applied to claim **1** above, discloses all the limitations of claim **1**.

Nishikawa et al. suggests an invention for providing a combined SIM card and a telephone calling card that are removable from one another (See Fig 47B).

Pentz et al. suggests an invention for a miniature credit card (See Figs 4A-D).

Nishikawa et al. and Smith et al. and Pentz et al. do not specifically teach wherein the token extends to only one corner of the card body and wherein the corner has a furthest distance from the microcircuit card.

Lubking suggests and invention for combining a credit card and a miniature credit card that are removable from one another (See Fig 4).

Lubking et al. discloses wherein the token extends to only one corner of the card body and wherein the corner has a furthest distance from the microcircuit card (See Fig 4 where, in general, the phrase "extends to" or "extending up to" can be considered synonymous with "extends towards" or "extending up towards").

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the teachings of Nishikawa et al. with the invention of Lubking in order to provide a customer with a removable miniature credit card in a full credit card package that may also function as a telephone calling card (See Lubking, Figs 4 and 7).

Regarding claim **5**, Nishikawa et al. discloses wherein the token has sides at least approximately parallel to those of the card body (Fig 47B).

Regarding claim **6**, Nishikawa et al. discloses wherein the token has sides at least approximately aligned with the sides of the microcircuit card (Fig 47B).

Regarding claims **18 and 20**, Nishikawa et al. discloses wherein the token includes a magnetic strip configured to store information (Fig 38, item 75).

c) Claims **29-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Blank (US 6,588,658) in view of Nishikawa et al. (US 5,581,065).

Regarding claims **29-30**, Blank discloses all the limitations of claims **1 and 27**, respectively.

Blank suggests that the transaction card "may have any suitable dimensions or have any other feature to meet with desired ANSI and ISO specifications for transaction cards" (Col 2 line 66 thru Col 3: line 2) and that the "auxiliary member may meet ANSI and ISO specifications" (Abstract).

Blank does not specifically teach wherein the card body conforms to ID-1 format and wherein the microcircuit card conforms to ID-000 format.

Nishikawa et al. discloses wherein the card body conforms to ID-1 format (Col 27, lines 4-6 and Col 21, lines 25-27) and wherein the microcircuit card conforms to ID-000 format (Col 1, line 21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the teachings of Blank with the invention of Nishikawa et al. in order to incorporate a microchip in a credit card sheet carrier (Nishikawa et al., Col 1: lines 9-13 and Fig 38).

Response to Arguments

4. Regarding claims **1** and its respective dependent claims, applicant has amended claim **28** to clarify that "the remainder portion" is extending along outermost sides of the card body to form three outermost corners of the card" and has argued that the previously cited prior art references do not teach this additional limitation in combination with claim **1**. Applicant further adds new claims **29 and 30** and has argued that the previously cited prior art references do not teach the limitations of this new combination of claims.

Applicants arguments with respect to claim **1** and its dependent claims have been considered but are moot in view of the new ground(s) of rejection presented.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Andler whose telephone number is (571) 270-5385 and whose e-mail address is michael.andler@uspto.gov. The examiner can normally be reached on Monday-Friday 7:30 AM to 3:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Andler/
Examiner, Art Unit 2876

/Michael G Lee/
Supervisory Patent Examiner, Art Unit 2876